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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,638	10/31/2003	Tsutomu Matsuzaki	062709-0115	8489

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EXAMINER
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HUSON, MONICA ANNE

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/697,638

Applicant(s)

MATSUZAKI ET AL.

Examiner

Monica A. Huson

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 and 31-34 is/are pending in the application.
- 4a) Of the above claim(s) 1-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-29 and 31-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This office action is in response to the RCE filed 5 April 2006.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 16-18, 20-24, 26, 28, and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Chomier et al. (U.S. Patent 6,858,276). Regarding Claim 16, Chomier et al., hereafter “Chomier,” show that it is known to carry out a method for manufacturing a cross member, which is configured to extend in a width direction of a vehicle body and which is configured to have both ends connected to side framework structures of the vehicle body (Abstract; Column 5, lines 47-67), the method comprising the steps of forming, from a material, a base frame extending in the width direction of the vehicle body by means of resinous molding, the base frame being formed to have a substantially circular or oval cross section (Column 3, lines 23-29; Column 5, lines 17-21, 47-67); forming a plurality of bosses on an outer circumferential surface on the base frame (Column 2, lines 15-23; It is noted that the location of the bosses is not interpreted as materially affecting the stepwise nature of

Art Unit: 1732

the claim, specifically the step of “forming a plurality of bosses”. To be entitled to weight in method claims, recited structural limitations must affect the method in a manipulative sense and not amount to mere claiming of a use of a particular structure. *Ex parte Pfeiffer* 135 USPQ 31.); and insert molding the base frame, within limited ranges thereof in the width direction of the vehicle body, in resinous material belonging to a same material system as the material of the base frame, thereby forming reinforcing frame parts integral with the base frame, the reinforcing frame parts being molded to have substantially circular or oval cross sections (Column 3, lines 32-63; Column 4, lines 45-64; Column 5, lines 1-8, 22-28).

Regarding Claim 17, Chomier shows the process as claimed as discussed in the rejection of Claim 16 above, including a method wherein the base frame is produced by injection molding (Column 5, lines 16-28).

Regarding Claim 18, Chomier shows the process as claimed as discussed in the rejection of Claim 16 above, including a method wherein the reinforcing frame parts are produced by means of insert molding while inserting part of the base frame into a molding die (Column 4, lines 45-64; Column 5, lines 1-8).

Regarding Claim 20, Chomier shows the process as claimed as discussed in the rejection of Claim 16 above, including a method wherein the base frame and the reinforcing frame parts are made from same engineering material or plural engineering plastic materials belonging to the same material system (Column 5, lines 22-27).

Regarding Claim 21, Chomier shows the process as claimed as discussed in the rejection of Claim 20 above, including a method wherein the base frame is made from resinous material containing a reinforcing material (Column 5, lines 17-46).

Regarding Claim 22, Chomier shows the process as claimed as discussed in the rejection of Claim 20 above, including a method wherein the reinforcing

frame parts are made from resinous material containing a reinforcing material (Column 5, lines 22-46).

Regarding Claim 23, Chomier shows the process as claimed as discussed in the rejection of Claim 16 above, including a method wherein the base frame has a hollow part to serve as part of an air conditioning duct (Column 5, lines 47-67).

Regarding Claim 24, Chomier shows the process as claimed as discussed in the rejection of Claim 21 above, including a method wherein the reinforcing material contains glass fiber (Column 5, lines 29-32).

Regarding Claim 26, Chomier shows the process as claimed as discussed in the rejection of Claim 22 above, including a method wherein the reinforcing material contains glass fiber (Column 5, lines 29-32).

Regarding Claim 28, Chomier shows the process as claimed as discussed in the rejection of Claim 18 above, including a method wherein the reinforcing frame parts are produced by means of injection molding while inserting a part of the base frame (Column 4, lines 45-64; Column 5, lines 1-8).

Regarding Claim 29, Chomier shows the process as claimed as discussed in the rejection of Claim 16 above, including a method comprising accommodating the base frame in the molding die (Column 4, lines 45-64; It is noted that the height of the bosses is not interpreted as materially affecting the stepwise nature of the claim, specifically the step of “accommodating the base frame in a molding die”. To be entitled to weight in method claims, recited structural limitations must affect the method in a manipulative sense and not amount to mere claiming of a use of a particular structure. *Ex parte Pfeiffer* 135 USPQ 31.); and filling up a cavity between the outer circumferential surface of the base frame and the inner surface of the molding die with molten resin to provide the reinforcing frame parts by hardening the molten resin, whereby the base frame is covered with the reinforcing frame parts (Column 3, lines 14-63; Column 4, lines 45-64; Column 5, lines 1-8).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chomier, in view of Hier et al. (U.S. Patent 6,568,707).

Regarding Claim 19, Chomier shows the process as claimed as discussed in the rejection of Claim 16 above, including showing that one frame part is more rigid than another (Column 3, lines 3-8). However, Chomier does not specifically show that the reinforcing frame part is higher in rigidity than the material of the base frame. Hier et al., hereafter "Hier," show that it is known to carry out a manufacturing method wherein the material of the reinforcing frame parts is higher in rigidity than the material of the base frame (Column 3, lines 62-67; Column 4, lines 1-4). Hier and Millif are combinable because they are concerned with a similar technical field, namely, molding processes which yield vehicle parts. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Hier's rigidity teachings in Chomier's molding process in order to obtain an article which has the appropriate structure to be useful in a vehicular environment.

Regarding Claim 34, Chomier shows that it is known to carry out a method for manufacturing a cross member, which is configured to extend in a width direction of a vehicle body and which is configured to have both ends connected to side framework structures of the vehicle body (Abstract; Column 5, lines 47-67), the method comprising the steps of forming, from a material, a

Art Unit: 1732

base frame extending in the width direction of the vehicle body by means of resinous molding, the base frame being formed to have a substantially circular or oval cross section (Column 3, lines 23-29; Column 5, lines 17-21, 47-67); forming a plurality of bosses on an outer circumferential surface on the base frame (Column 2, lines 15-23; It is noted that the location of the bosses is not interpreted as materially affecting the stepwise nature of the claim, specifically the step of "forming a plurality of bosses". To be entitled to weight in method claims, recited structural limitations must affect the method in a manipulative sense and not amount to mere claiming of a use of a particular structure. *Ex parte Pfeiffer* 135 USPQ 31.); and insert molding the base frame, within limited ranges thereof in the width direction of the vehicle body, in resinous material belonging to a same material system as the material of the base frame, thereby forming reinforcing frame parts integral with the base frame, the reinforcing frame parts being molded to have substantially circular or oval cross sections (Column 3, lines 32-63; Column 4, lines 45-64; Column 5, lines 1-8, 22-28). Although Chomier shows that one frame part is more rigid than another (Column 3, lines 3-8), he does not specifically show that the reinforcing frame part is higher in rigidity than the material of the base frame. Hier shows that it is known to carry out a manufacturing method wherein the material of the reinforcing frame parts is higher in rigidity than the material of the base frame (Column 3, lines 62-67; Column 4, lines 1-4). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Hier's rigidity teachings in Chomier's molding process in order to obtain an article which has the appropriate structure to be useful in a vehicular environment.

Claims 25, 27, and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chomier.

Regarding Claim 25, Chomier shows the process as claimed as discussed in the rejection of Claim 21 above, but he does not show a specific reinforcing composition or physical property values thereof. However, it is well established that proportions or values are critical only when they involve a difference in kind rather than degree (*In re Touvay et al.*, 121 USPQ 265). Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to select an appropriate reinforcing composition that allows for production of an article which satisfies particular end-use specifications.

Regarding Claim 27, Chomier shows the process as claimed as discussed in the rejection of Claim 22 above, but he does not show a specific reinforcing composition or physical property values thereof. However, it is well established that proportions or values are critical only when they involve a difference in kind rather than degree (*In re Touvay et al.*, 121 USPQ 265). Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to select an appropriate reinforcing composition that allows for production of an article which satisfies particular end-use specifications.

Regarding Claims 31-33, Chomier shows the process as claimed as discussed in the rejection of Claim 29 above, but he does not show specific configuration details of the bosses. However, it is noted that the structural configuration of the bosses is not interpreted as materially affecting the stepwise nature of the claim. To be entitled to weight in method claims, recited structural limitations must affect the method in a manipulative sense and not amount to mere claiming of a use of a particular structure (*Ex parte Pfeiffer* 135 USPQ 31).



**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica A. Huson whose telephone number is 571-272-1198. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Monica A Huson

May 15, 2006